

## **REMARKS**

This is a full and timely response to the outstanding final Office Action mailed May 13, 2005. Through this response, independent claims 1, 7, 11, 17, 22, and 27 have been amended to place the claims in condition for allowance or, alternatively, in better condition for appeal, and claims 6, 13, 21, and 23 have been canceled and incorporated into their respective independent claim. Reconsideration and allowance of the application and pending claims 1-5, 7-12, 14-20, 22, and 24-28 are respectfully requested.

### **I. Claim Rejections - 35 U.S.C. § 102(e)**

#### **A. Statement of the Rejection - Claims 1-2, 4-8, 10-13, 16-18, 20-23, and 26-28**

Claims 1-2, 4-8, 10-13, 16-18, 20-23, and 26-28 have been rejected under 35 U.S.C. § 102(e) as allegedly anticipated by *Smith et al.* ("Smith," U.S. Pat. No. 6,192,407). Applicant respectfully traverses this rejection.

#### **B. Discussion of the Rejection**

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)(emphasis added). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

#### **Independent Claim 1**

Claim 1 recites (emphasis added):

1. A method for a computer to deliver an electronic document to an Internet appliance, the method comprising the steps of:

*configuring a document for a one-time use, wherein configuring comprises dynamically assigning a single-use document address to the*

*requested document independent of an intended recipient*, wherein the single-use document address is a uniform resource locator address; receiving an access request for the document from the Internet; sending the requested document to the Internet appliance; and *deleting the single-use document address assigned to the requested document after the requested document has been sent to the Internet appliance.*

Applicant respectfully submits that *Smith* does not disclose, teach, or suggest the emphasized claim features. The Office Action provides the following response to intended use features in Section 2, page 2:

In response to applicant's argument that the *smith* reference does not teach that a document is configured for one-time use, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim...Note that *Smith* dedicates a significant portion of the text (col. 7, line 37 – col. 9, line 42) to illustrating an embodiment of the invention wherein a document is configured for one-time use [by uploading to a document store for the sole purpose of transmitting to another user], is transmitted to exactly one user, and then is deleted so as to render further access of said document impossible.

Applicant has amended independent claim 1 (incorporating features of dependent claim 6 and further including the independence feature inherent from Applicant's specification) to clarify that a mechanism by which the method described in claim 1 configures a document for one-time use includes *dynamically assigning a single-use document address to the requested document independent of an intended recipient*. The "structural difference" between what is claimed and what is found in *Smith* can be found in the difference in computer system logic that enables the single-use document address to be assigned "independent of an intended recipient," in contrast to what is disclosed in *Smith*. In particular, *Smith* provides that the PURL uniquely identifies the intended recipient and the document (col. 15, line 10), and also provides that the "server dynamically generates a URL for each intended recipient." (col. 15,

lines 32-33) A consequence of the mechanisms described in *Smith* is that there may be multiple access of the same document. (col. 16, lines 3-6) In contrast, by ***assigning a single-use document address to the requested document independent of an intended recipient***, such repeated access can be avoided.

Further, the Office Action provides the following response with regard to inherency and deletion of the single-use address:

This argument is deemed moot in view of Examiner's discovery of an explicit teaching within the Smith reference that the document (and thus by extension, the PURL) is deleted after transmission (col. 8, lines 40-50, and col. 9, lines 28-30).

Applicant respectfully submits that this section from *Smith* is misplaced, and thus respectfully disagrees with the assertions contained in this Office Action section. The sections cited in col. 8, lines 40-50 and col. 9, lines 28-30 appear to relate to the "push" embodiment that uses a store 42 and store items 48 associated with an email attachment. In contrast, the PURL embodiment is described in columns 14-17. Although *Smith* discloses that PURLs are temporary, it is not disclosed, taught, or suggested that that the PURLS are ***independent of an intended recipient***, or that they are deleted ***after the requested document has been sent to the Internet appliance*** (e.g., though not discussed, the PURLS in *Smith* may be deleted after a lapse of time of nonuse) as recited in independent claim 1. Thus, Applicant respectfully submits that *Smith* does not disclose, teach, or suggest the emphasized features, and respectfully requests that the rejection to independent claim 1 be withdrawn.

Because independent claim 1 is allowable over *Smith*, dependent claims 2-5 are allowable as a matter of law for at least the reason that the dependent claims 2-5 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

### **Independent Claim 7**

Claim 7 recites (emphasis added):

7. A method for making a document that is stored on a remote server to be accessible on the Internet according to a temporary document address assigned to the document, the method comprising the steps of:

issuing a request to the remote server to retrieve a document configured for one-time use; and

*receiving a recipient independent, temporary document address* from the remote server, wherein the document is accessible on the Internet according to the temporary document address assigned to the document; and

communicating the received temporary document address to a remote Internet appliance, wherein the Internet appliance retrieves the document from the remote server according to the received temporary document address.

Applicant respectfully submits that *Smith* does not disclose, teach, or suggest the emphasized claim features. Applicant has amended independent claim 7 to clarify that the temporary document address is *recipient independent*. As explained above in association with independent claim 1, *Smith* provides that the PURL uniquely identifies the intended recipient and the document (col. 15, line 10), and also provides that the “server dynamically generates a URL for each intended recipient.” (col. 15, lines 32-33) Thus, Applicant respectfully submits that *Smith* does not disclose, teach, or suggest the emphasized features, and respectfully requests that the rejection to independent claim 7 be withdrawn.

Because independent claim 7 is allowable over *Smith*, dependent claims 8-10 are allowable as a matter of law.

### **Independent Claim 11**

Claim 11 recites (emphasis added):

11. A method for making a document available on the Internet according to a dynamically assigned single-use document address, comprising the steps of:

generating a request to a web server for the document from a requesting device;

retrieving the document from a storage location upon receipt of the request;

***configuring the retrieved document for one-time use, wherein configuring comprises dynamically assigning a single-use document address to the retrieved document independent of an intended recipient;***

sending the single-use document address to the requesting device, wherein the single-use document address is communicated to an Internet appliance;

downloading the retrieved document from the web server according to the single-use document address; and

***terminating the single-use document address after downloading the retrieved document.***

Applicant respectfully submits that *Smith* does not disclose, teach, or suggest the emphasized claim features. Applicant has amended independent claim 11 (incorporating features of dependent claim 13 and further including the independence feature inherent from Applicant's specification) to clarify that a mechanism by which the method described in claim 11 configures a document for one-time use includes ***dynamically assigning a single-use document address to the requested document independent of an intended recipient.*** The "structural difference" between what is claimed and what is found in *Smith* can be found in the difference in computer system logic that enables the single-use document address to be assigned "independent of an intended recipient," in contrast to what is disclosed in *Smith*. In particular, *Smith* provides that the PURL uniquely identifies the intended recipient and the document (col. 15, line 10), and also provides that the "server dynamically generates a URL for each intended recipient." (col. 15, lines 32-33) A consequence of the mechanisms described in *Smith* is that there may be multiple access of the same document. (col. 16, lines 3-6) In contrast, by ***assigning a single-use document address to the requested document independent of an intended recipient,*** such repeated access can be avoided.

Further, as explained in association with independent claim 1, Applicant respectfully submits the section from *Smith* cited in the Office Action to refute the inherency arguments presented in the last response is misplaced, and thus respectfully disagrees with the assertions

contained in this Office Action section. The sections cited in col. 8, lines 40-50 and col. 9, lines 28-30 appear to relate to the “push” embodiment that uses a store 42 and store items 48 associated with an email attachment. In contrast, the PURL embodiment is described in columns 14-17. Although *Smith* discloses that PURLs are temporary, it is not disclosed, taught, or suggested that that the PURLS are *independent of an intended recipient*, or that they are terminated *after downloading the retrieved document* (e.g., though not discussed, the PURLS in *Smith* may be deleted after a lapse of time of nonuse) as recited in independent claim 11. Thus, Applicant respectfully submits that *Smith* does not disclose, teach, or suggest the emphasized features, and respectfully requests that the rejection to independent claim 11 be withdrawn.

Because independent claim 11 is allowable over *Smith*, dependent claims 12 and 14-16 are allowable as a matter of law.

### **Independent Claim 17**

Claim 17 recites (with emphasis added):

17. A system to deliver an electronic document to a remote Internet appliance, comprising:

logic configured to receive a request for the document from a requesting source;

*logic configured to configure the document for a single use, wherein to configure the document for a single use comprises dynamically assigning a single-use document address to the requested document independent of an intended recipient;*

logic configured to send the document to the remote Internet appliance upon receipt of a request for the document via the assigned single-use document address; and

*logic configured to delete the single-use document address assigned to the requested document after the requested document has been sent to the remote Internet appliance.*

Applicant respectfully submits that *Smith* does not disclose, teach, or suggest the emphasized claim features. Applicant has amended independent claim 17 (incorporating features of dependent claim 21 and further including the independence feature inherent from Applicant’s

specification) to clarify that a mechanism by which the system described in claim 17 configures a document for one-time use includes *dynamically assigning a single-use document address to the requested document independent of an intended recipient*. The “structural difference” between what is claimed and what is found in *Smith* can be found in the difference in computer system logic that enables the single-use document address to be assigned “independent of an intended recipient,” in contrast to what is disclosed in *Smith*. In particular, *Smith* provides that the PURL uniquely identifies the intended recipient and the document (col. 15, line 10), and also provides that the “server dynamically generates a URL for each intended recipient.” (col. 15, lines 32-33) A consequence of the mechanisms described in *Smith* is that there may be multiple access of the same document. (col. 16, lines 3-6) In contrast, by *assigning a single-use document address to the requested document independent of an intended recipient*, such repeated access can be avoided.

Further, with regard to the inherency argument and deletion of the single-use address, Applicant respectfully submits that the section from *Smith* used to refute the inherency arguments presented in the last response is misplaced, and thus respectfully disagrees with the assertions contained in this Office Action section. The sections cited in col. 8, lines 40-50 and col. 9, lines 28-30 appear to relate to the “push” embodiment that uses a store 42 and store items 48 associated with an email attachment. In contrast, the PURL embodiment is described in columns 14-17. Although *Smith* discloses that PURLs are temporary, it is not disclosed, taught, or suggested that that the PURLS are *independent of an intended recipient*, or that they are deleted *after the requested document has been sent to the Internet appliance* (e.g., though not discussed, the PURLS in *Smith* may be deleted after a lapse of time of nonuse) as recited in independent claim 17. Thus, Applicant respectfully submits that *Smith* does not disclose, teach, or suggest the emphasized features, and respectfully requests that the rejection to independent claim 17 be withdrawn.

Because independent claim 17 is allowable over *Smith*, dependent claims 18-20 are allowable as a matter of law.

### Independent Claim 22

Claim 22 recites (emphasis added):

22. A system for making a document available on the Internet according to a dynamically assigned single-use document address, comprising:

logic configured to generate a request to a web server for the document from a requesting device;

logic configured to implement the web server to retrieve the document from a secure storage location upon receipt of the request;

*logic configured to implement the web server to configure the retrieved document for one-time use, wherein the logic configured to configure the retrieved document for one-time use is configured to dynamically assign a single-use document address to the retrieved document independent of an intended recipient;*

logic configured to implement the web server to send the single-use document address to the requesting device;

logic configured to implement the requesting device to communicate the single-use document address to an Internet appliance;

logic configured to implement the Internet appliance to download the retrieved document from the web server according to the single-use document address; and

*logic configured to implement the web server to terminate the single-use document address after downloading the retrieved document to the Internet appliance.*

Applicant respectfully submits that *Smith* does not disclose, teach, or suggest the emphasized claim features. Applicant has amended independent claim 22 (incorporating features of dependent claim 23 and further including the independence feature inherent from Applicant's specification) to clarify that a mechanism by which the system described in claim 22 configures a document for one-time use includes *dynamically assigning a single-use document address to the requested document independent of an intended recipient*. The "structural difference" between what is claimed and what is found in *Smith* can be found in the difference in computer system logic that enables the single-use document address to be assigned "independent of an intended recipient," in contrast to what is disclosed in *Smith*. In

particular, *Smith* provides that the PURL uniquely identifies the intended recipient and the document (col. 15, line 10), and also provides that the “server dynamically generates a URL for each intended recipient.” (col. 15, lines 32-33) A consequence of the mechanisms described in *Smith* is that there may be multiple access of the same document. (col. 16, lines 3-6)

3-6) In contrast, by ***assigning a single-use document address to the requested document independent of an intended recipient***, such repeated access can be avoided.

Further, with regard to the inherency argument and deletion of the single-use address, Applicant respectfully submits that the section from *Smith* used to refute the inherency arguments presented in the last response is misplaced, and thus respectfully disagrees with the assertions contained in this Office Action section. The sections cited in col. 8, lines 40-50 and col. 9, lines 28-30 appear to relate to the “push” embodiment that uses a store 42 and store items 48 associated with an email attachment. In contrast, the PURL embodiment is described in columns 14-17. Although *Smith* discloses that PURLs are temporary, it is not disclosed, taught, or suggested that that the PURLS are ***independent of an intended recipient***, or that they are deleted ***after the requested document has been sent to the Internet appliance*** (e.g., though not discussed, the PURLS in *Smith* may be deleted after a lapse of time of no use) as recited in independent claim 22. Thus, Applicant respectfully submits that *Smith* does not disclose, teach, or suggest the emphasized features, and respectfully requests that the rejection to independent claim 22 be withdrawn.

Because independent claim 22 is allowable over *Smith*, dependent claims 24-26 are allowable as a matter of law.

### **Independent Claim 27**

Claim 27 recites (emphasis added):

27. A system for making a document available on the Internet according to a dynamically assigned single-use document address, comprising:

means for requesting the document;

means for retrieving the document from a secure storage location upon receipt of the request;

*means for configuring the retrieved document for single-use, wherein configuring the document for a single-use comprises dynamically assigning a single use document address to the requested document independent of an intended recipient;*

means for downloading the retrieved document according to the single-use document address; and

*means for terminating the single-use document address after downloading the retrieved document.*

Applicant respectfully submits that *Smith* does not disclose, teach, or suggest the emphasized claim features. Applicant has amended independent claim 27 consistent with claim amendments described above to clarify that a mechanism by which the system described in claim 27 configures a document for one-time use includes *dynamically assigning a single-use document address to the requested document independent of an intended recipient*. The “structural difference” between what is claimed and what is found in *Smith* can be found in the difference in computer system logic that enables the single-use document address to be assigned “independent of an intended recipient,” in contrast to what is disclosed in *Smith*. In particular, *Smith* provides that the PURL uniquely identifies the intended recipient and the document (col. 15, line 10), and also provides that the “server dynamically generates a URL for each intended recipient.” (col. 15, lines 32-33) A consequence of the mechanisms described in *Smith* is that there may be multiple access of the same document. (col. 16, lines 3-6) In contrast, by *assigning a single-use document address to the requested document independent of an intended recipient*, such repeated access can be avoided.

Further, with regard to the inherency argument and deletion of the single-use address, Applicant respectfully submits that the section from *Smith* used to refute the inherency arguments presented in the last response is misplaced, and thus respectfully disagrees with the assertion contained in this Office Action section. The sections cited in col. 8, lines 40-50 and

col. 9, lines 28-30 appear to relate to the “push” embodiment that uses a store 42 and store items 48 associated with an email attachment. In contrast, the PURL embodiment is described in columns 14-17. Although *Smith* discloses that PURLs are temporary, it is not disclosed, taught, or suggested that that the PURLS are *independent of an intended recipient*, or that they are terminated *after downloading the retrieved document* (e.g., though not discussed, the PURLS in *Smith* may be deleted after a lapse of time of no use) as recited in independent claim 27. Thus, Applicant respectfully submits that *Smith* does not disclose, teach, or suggest the emphasized features, and respectfully requests that the rejection to independent claim 27 be withdrawn.

Because independent claim 27 is allowable over *Smith*, dependent claim 28 is allowable as a matter of law.

## **II. Claim Rejections - 35 U.S.C. § 103(a)**

### **A. Statement of the Rejection - Claims 3, 9, 14-15, 19, and 24-25**

Claims 3, 9, 14-15, 19, and 24-25 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Smith* as applied to claims 1, 7, 11, 17, and 22 above, and further in view of *Schneier* (“*Schneier*”, “Applied Cryptography”, 2<sup>nd</sup> edition). Applicant respectfully traverses this rejection.

### **B. Discussion of the Rejection**

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a proper case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

Accordingly, to make a proper case for obviousness, there must be a prior art teaching or established knowledge that would suggest to a person having ordinary skill in the pertinent art to fill the voids apparent in the applied reference. It is respectfully asserted that no such case has been made in the outstanding Office Action.

As explained above, *Smith* fails to disclose the above emphasized features found in independent claims 1, 7, 11, 17, 22, and 27. Because dependent claims 2-5, 8-10, 12, 14-16, 18-20, 24-26, and 28 contain the features of their respective independent claims, and since *Schneier* does not remedy these deficiencies, Applicant respectfully submits that the combination of *Smith* in view of *Schneier* fails to disclose, teach, or suggest the emphasized claim features. Thus, Applicant respectfully requests that the rejection to claims 3, 9, 14-15, 19, and 24-25 be withdrawn.

**CONCLUSION**

Applicant respectfully submit that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. Applicant has amended the claims to incorporate dependent claim features, but does so, without prejudice, waiver, or disclaimer, in the interest of expediting issuance of the application. Applicant reserves the right to present broader independent claims in continuing applications to be filed subsequently. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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**David Rodack**  
**Registration No. 47,034**